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PATENT APPLICATION
09/784,800

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Joseph S. Gordon et al.
Serial No.: 09/784,800
Filing Date: February 15, 2001
Group Art Unit: 2872
Examiner: Chang, Audrey Y.
Title: **APPARATUS AND METHOD FOR OPTIMIZING
A PELLICLE FOR OFF-AXIS TRANSMISSION
OF LIGHT**

MAIL STOP – AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review (“Request”) is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 (“OG Notice”). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

REMARKS

Applicants contend that the rejections of Claims 7, 9-14, 16-24 and 26-30 under 35 U.S.C. §§ 112, first paragraph and 103 contain clear legal and factual deficiencies, as described below. As of the time of the Final Office Action dated May 30, 2005, Claims 7, 9-14, 16-24 and 26-30 were rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement and allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Claims 7, 9-14, 16-24 and 26-30 stand rejected under 25 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,742,386 issued to Noriyuki Nose et al. ("*Nose*") in view of U.S. Patent No. 4,657,805 issued to Yasunori Fukumistu et al. ("*Fukumistu*") and U.S. Patent No. 4,966,457 issued to Fuminori Hayano et al ("*Hayano*"). Claims 9, 12, 19, 21 and 29 stand objected to because of formalities. Applicants request a finding that these rejections are improper and allowance of these claims.

With respect to independent Claims 7, 17 and 26, the Examiner has continued to allege, over the Applicants' arguments, that Claims 7, 9-14, 16-24, and 26-30 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention, and that Claims 7, 9-14, 16-24 and 26-30 contain subject matter not described in the specification on such a way as to enable one skilled in the art to which it pertains to make and use the invention. (Final Office Action, Pages 4-6). Applicants contend that the specification does adequately describe that the Applicants had possession of the claimed invention and does enable the invention for the reasons described in Applicants' Response dated July 31, 2006 at Pages 8-21.¹

Specifically, the Examiner bases this rejection on allegedly newly added matter in the amendments filed on February 9, 2005. For the reasons described in Applicants' Response dated July 31, 2006, no new matter has been added and the amendments are fully supported by Applicants' specification. Accordingly, Applicants respectfully request reconsideration

¹ It is noted in the OG Notice at <http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm> that "Applicants are encouraged to refer to arguments already of record rather than repeating them in the request." Accordingly, Applicants refer here to, and summarize, the previous arguments rather than reciting them explicitly.

and withdrawal of the rejections to Claims 7, 9-14, 16-24 and 26-30.

Claims 7, 9-14, 16-24, and 26-30 additionally stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.² As detailed in Applicants' Response dated July 31, 2006, the Examiner's arguments are inconsistent with other arguments advanced by the Examiner. (Response, Pages 19-20). In addition, Applicants have previously shown that the specification provides adequate support for the enablement of the recited claims. (Response, Pages 20-21).

Because the Applicants' arguments in response to these rejections are too voluminous to meet the page limitations set forth in the OG Notice, Applicants cite generally to Pages 8-21 of their Response dated July 31, 2006. In particular, Applicants note that the Examiner's rejection is based in part on the premise that:

Out of all citations of different portions of the specification, the applicant fails to provide just one single paragraph which explicitly states, "light is transmitted at the particular wavelength through opening in the photomask, through the thin film and onto wafer to project an image of the photomask opening onto the wafer, wherein a portion of the transmitted light is diffracted by the photomask opening and passes through the thin film at the angle of incidence greater than zero" as recited in Claims 7, and 17 or "projecting the radiant energy through opening in the photomask, through the thin film and onto wafer to form an image of the photomask opening in the wafer, wherein a portion of the projected light is diffracted by the photomask opening and passes through the thin film at the angle of incidence greater than zero" as recited in claim 26. The piece meals presentation fails to provide the explicit features recited in the claims.

(Final Office Action, Pages 12-13).

However, as noted by the Applicants in their response, Applicants are unaware of any statute, regulation or portion of the M.P.E.P. that requires the Applicants to "provide ... one paragraph which explicitly states" the claimed elements. In fact, "[t]o comply with the written description requirement of 35 U.S.C. § 112, para. 1 ..., each claim limitation must be

² Specifically, the Examiner states that the phrase "the transmission of such portion of light . . . produce an increased resolution of the projected image on the wafer," as recited in Claim 7 and the phrase "projection of the diffracted portion of light . . . increase the resolution of the image," as recited in Claim 26 are not enabled by the disclosure because "[t]he resolution of a projected image therefore is implicitly defined at least in part by the size of spatial information of the photomask, but not by the projection of certain portion of the light." (Final Office Action, Page 5).

expressly, *implicitly*, or *inherently* supported in the originally filed disclosure.” M.P.E.P. § 2163(II)(A)(3)(b) (emphasis added); *see also*, *Hyatt v. Boone*, 146 F.3d 1348, 1353, 47 U.S.P.Q.2d 1128, 1131 (Fed. Cir. 1998). The language quoted above does not require that each claim limitation to be “explicitly” stated within “one paragraph” of the disclosure, but instead that claim limitations must be expressly, implicitly, or inherently supported in the disclosure. Applicants have repeatedly shown during the prosecution of this Application that the specification, taken as a whole, supports the claimed elements. M.P.E.P. § 2163(II)(A)(2) (“Prior to determining whether the disclosure satisfies the written description requirement for the claimed subject matter, the examiner should review the claims and the *entire specification*, including the specific embodiments, [and] figures, ... to understand how applicant provides support for the various features of the claimed invention.”) (emphasis added). Applicants submit that the portions of the specification cited specifically in Applicants’ Response expressly, and at the very least, implicitly and inherently, support the recited elements of the Claims. Thus, even if, as the Examiner alleges, “the specification loosely discloses” recited claim elements, such disclosure is sufficient to comply with the requirements of 35 U.S.C. § 112, first paragraph.

In addition, with respect to Claims 7, 17, and 26, the Examiner contends that the combination *Nose*, *Fukumitsu* and *Hayano* teach, disclose, suggest or otherwise render obvious each element of Claims 7, 17, and 26. (Final Office Action, Pages 6-12). Applicants contend that taken together or individually, *Nose*, *Fukumitsu* and *Hayano* fail to teach, disclose, suggest or otherwise render obvious each element of Claims 7, 17, and 26 for the reasons described in Applicants’ Response dated July 31, 2006 at Pages 24-28, and Applicants’ Response dated February 10, 2005 at Pages 10-13. As discussed in these Responses, Applicants respectfully submit that the cited references fail to disclose every element of Claims 7, 17 and 26 as is required to maintain an obviousness rejection under 35 U.S.C. § 103(a), and there is no motivation, teaching, or suggestion to combine *Nose*, *Hayano* and *Fukumistu*.

Furthermore, with respect to Claims 9, 12, 19, 21 and 29, were objected to by the Examiner because of informalities. Specifically, the Examiner states:

it is not understandable how the thin film having thickness that gives peak transmission for **off-axis** or **non-normal incident light** but is able to give peak transmission that is *1 nanometer* above the “particular wave length.” It is

impossible to have this kind of accuracy for light having wave length differing in one nanometer to give so different transmission property.

(Final Office Action, Page 6) (emphasis in original). Applicants contend that such objection is improper for the reasons described in Applicants' Response dated July 31, 2006 at Pages 22-24.

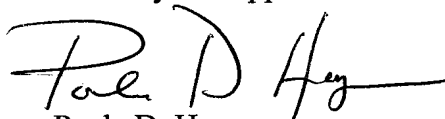
CONCLUSION

Applicants submit these Arguments in Support of Pre-Appeal Brief Request for Review along with a Notice of Appeal. Applicants hereby authorize the Commissioner to charge the filing fee of \$500.00 for the Notice of Appeal to Deposit Account No. 50-2148 of Baker Botts L.L.P.

Applicants believe there are no further fees due at this time; however, the Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayments to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this request that may be cleared up in a telephone conversation, please contact Applicants' attorney, Paula D. Heyman, at 512.322.2581.

Respectfully submitted,
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Date: Aug. 30, 2006

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